



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/935,430      | 08/22/2001  | Mary Faris           | 511582005000        | 9082             |

25225 7590 10/25/2002  
MORRISON & FOERSTER LLP  
3811 VALLEY CENTRE DRIVE  
SUITE 500  
SAN DIEGO, CA 92130-2332

|          |
|----------|
| EXAMINER |
|----------|

PRIEBE, SCOTT DAVID

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1632

DATE MAILED: 10/25/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/935,430**

Applicant(s)  
**Faris et al.**

Examiner  
**Scott D. Priebe, Ph.D.**

Art Unit  
**1632**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-66 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 1632

## **DETAILED ACTION**

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, 37-40, drawn to a method for monitoring or detecting 158P1D7 mRNA from cancer patient, classified in class 435, subclass 6.
- II. Claims 1-3, 37-38, drawn to a method for monitoring or detecting 158P1D7 protein from cancer patient, classified in class 435, subclass 7.23.
- III. Claims 4-7, 46, 60-66, drawn to 158P1D7-related protein, classified in class 530, subclass 350.
- IV. Claims 4-6, 8, 25-32 and 35, drawn to an antibody that binds a 158P1D7-related protein, classified in class 530, subclass 387.7.
- V. Claims 4-6, 9, 36, drawn to a polynucleotide encoding an antibody that binds a 158P1D7-related protein, classified in class 536, subclass 23.53.
- VI. Claims 4-6, 10, 41-45, 47-59, drawn to a polynucleotide encoding a 158P1D7-related protein, classified in class 536, subclass 23.5.
- VII. Claims 4-6, 11, 12, drawn to antisense polynucleotides to 158P1D7 coding sequence, classified in class 536, subclass 24.5.
- VIII. Claims 13, 14, 20, drawn to treatment of cancer with an antibody that binds a 158P1D7 protein, classified in class 424, subclass 156.1.

Art Unit: 1632

- IX. Claim 15, drawn to treatment of cancer with a polynucleotide encoding an antibody that binds a 158P1D7-related protein, classified in class 514, subclass 44.
- X. Claims 13, 16, 19 drawn to treatment of cancer with a polynucleotide encoding a 158P1D7-related protein, classified in class 514, subclass 44.
- XI. Claims 13, 17, 18, drawn to treatment of cancer with a antisense polynucleotides 158P1D7 coding sequence, classified in class 514, subclass 44.
- ✓XII. Claims 19, 21-24, drawn to a method for inducing an immune response in a mammal to a 158P1D7-related protein using 158P1D7-related protein, classified in class 424, subclass 277.1.
- ✓XIII. Claim 19, drawn to a method for inducing an immune response in a mammal to a 158P1D7-related protein using 158P1D7-related protein encoding polynucleotide, classified in class 514, subclass 44.
- XIV. Claim 33, drawn to a transgenic animal that produces an antibody that binds a 158P1D7-related protein, classified in class 800, subclass 13.
- XV. Claim 34, drawn to a hybridoma that produces an antibody that binds a 158P1D7-related protein, classified in class 435, subclass 330.

The inventions are distinct, each from the other because of the following reasons

Art Unit: 1632

Inventions VI or VII and invention I are related as product and process of use. Invention VI and inventions X or XIII are related as product and process of use. Inventions VII and invention XI are related as product and process of use. Inventions IV and inventions II or VIII are related as product and process of use. Inventions III and invention XII are related as product and process of use. Inventions V and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotides of either of groups VI or VII can be used in invention I, and invention VI can be used to make recombinant cells for producing protein or for treatment of cancer as in invention X, or for inducing an immune response in a mammal, as in invention XIII. Invention VII can also be used in treating cancer as in invention XI. The antibodies of invention IV can be used either in the assay of invention II or in the treatment of invention VIII or to affinity purify the protein of invention III. The protein of invention III can also be used to identify proteins which interact with 158P1D7. The polynucleotide of invention V can also be used to make recombinant cells which produce the antibodies.

Inventions III, IV, V, VI, VII, XIV and XV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are each directed to products which have different structures

Art Unit: 1632

and different uses. The compounds of inventions III-VII are structurally and functionally different compounds which do not have the same modes of operation or effect. The transgenic animal and hybridoma of inventions XIV and XV are not disclosed as usable with each other or with any of the products of inventions III-VII. They also have different modes of operation for producing antibodies.

Invention III and inventions I, II, VIII-XI, and XIII are unrelated. Invention IV and inventions I, and IX-XIII are unrelated. Invention V and inventions I, II, VIII, and X-XIII are unrelated. Invention VI and inventions I, II, VIII, IX and XI-XII are unrelated. Invention VII and inventions II, VIII-X, XII, and XIII are unrelated. Inventions XIV and XV and inventions I, II, and VIII-XIII are unrelated. In each instance, the products are not used in the methods.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for each invention is not required for the others, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

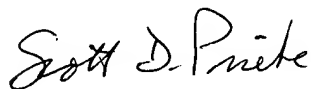
Art Unit: 1632

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Certain papers related to this application may be submitted to Art Unit 1632 by facsimile transmission. The FAX numbers are (703) 308-4242 or (703) 305-3014 for any type of communication. In addition, FAX numbers for a computer server system using RightFAX are also available for communications before final rejection, (703) 872-9306, and for communications after final rejection, (703) 872-9307, which will generate a return receipt. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott D. Priebe whose telephone number is (703) 308-7310. The examiner can normally be reached on Monday through Friday from 8 AM to 4 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051.

Any inquiry concerning administrative, procedural or formal matters relating to this application should be directed to Patent Analyst Patsy Zimmerman whose telephone number is (703) 308-8338. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Scott D. Priebe, Ph.D.  
Primary Examiner  
Technology Center 1600  
Art Unit 1632